UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

AUG 16 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTONIO J. COLMENAREZ

Application 09/988,944

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 14, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

On March 10, 2006, an Order Returning Undocketed Appeal to Examiner was mailed which requested that a substitute brief be filed in compliance with § 41.37(c) and that an Information Disclosure Statement (IDS) filed November 19, 2001 be considered. A Notice of Defective Brief

was mailed on May 16, 2006. In response, a new Appeal Brief was filed on June 20, 2006. On May 21, 2007, a Miscellaneous Action was mailed which stated that "[t]he Appeal Brief . . . appears to fully comply with 37 CFR 41.37."

37 CFR § 41.37 states, in part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
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> (c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:
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> (vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.
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> (vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are

argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

. . . .

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

It is noted that the Appeal Brief filed June 20, 2006 lists the "Grounds of Rejection to be Reviewed on Appeal" (entitled as "Statement/List of Each Ground for Review") as follows:

1. The Rejection of claims 1 and 3-20, on appeal, under 35 U.S.C. § 102(e), as being anticipated by Maruno et al. is improper [page 13]; and

2. The Rejection of claim 2, on appeal, under 35 U.S.C. § 103, as being unpatentable over Maruno et al. in view of Ullman is improper [page 17].

There does not appear to be a separate "Argument" section. As noted by 37 CFR 41.37(c)(1)(viii), the "Argument" section should include "[t]he contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on." Correction is required.

In addition, there is still no indication in the record that the IDS filed November 19, 2001 has been considered or that appellant has been notified regarding the Primary Examiner's decision. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to hold the Appeal Brief filed June 20, 2006 defective;

2) for notification to appellant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

3) for consideration of the substitute Appeal Brief;

4) for consideration of the IDS filed November 19, 2001 and proper notification to appellant regarding the Primary Examiner's decision; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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